

In re Patent Application of:

CHAPMAN ET AL.

Serial No. 09/596,629

Filing Date: June 19, 2000

REMARKS

Applicants would like to thank the Examiner for the thorough examination of the present application. The minor informalities in Claim 52 have been corrected as helpfully noted by the Examiner.

Please note that the Spencer patent cited by the Examiner as prior art has a filing date of August 23, 1999. This is after the June 28, 1999 priority date of the present invention. The subject matter of the pending claims is fully supported by the original provisional patent application. Nonetheless, the Applicants submit that even if the Spencer patent was a prior art reference, the claimed invention is still patentable, as based upon the arguments presented in detail below.

I. The Claims Are Patentable

The Examiner rejected independent Claims 1, 12, 22, 31, 42, 52 and 61 over the Spencer patent in view of the Forrest et al. patent.

The present invention, as recited in independent Claim 1, for example, is directed to a method for distributing an invention disclosure over an intranet. The method comprises creating and submitting an invention disclosure over the intranet, with the invention disclosure being submitted by an inventor to at least one evaluator via e-mail with a hyperlink to the invention disclosure. The method further comprises transmitting evaluation comments of the invention disclosure by the at least one evaluator via e-mail.

The method in accordance with the present invention advantageously allows users to exchange e-mail messages within

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the intranet for providing notification and status of the invention disclosure. Moreover, the hyperlinks embedded within selected e-mail messages advantageously allows a user to access the invention disclosure to provide a user friendly and efficient method of distributing an invention disclosure within an organization or company.

Referring now to the Spencer patent, an integrated web based system for generating electronic request for proposal (RFP) forms and responding to the generated RFPs over a secure network is disclosed. In general, Spencer discloses how a user can request specific information for goods and services from specific vendors, automates the process of responding to the RFPs, and automates the process of reviewing, analyzing and presenting the results. Potential vendors are notified via e-mail when the RFP is completed.

As correctly noted by the Examiner, Spencer fails to disclose that the RFP may be an invention disclosure, or that the secure network is an intranet, or the use of multiple e-mails for the notification and distribution of the hyperlinks.

The Examiner cited the Forrest et al. patent as disclosing an intranet for submitting an invention disclosure. The Examiner has also taken Official Notice that it is well known in the art at the time of the invention to send multiple e-mails instead of one for notification and hyperlink distribution purposes.

It appears that the Examiner is using impermissible hindsight reconstruction to modify Spencer in view of Forrest et al. in an attempt to produce the claimed invention. The Applicants respectfully maintain that obvious cannot be established by combining the teachings of Spencer in view of

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Forrest et al. to produce the claimed invention without some proper prior art teaching, suggestion or incentive supporting such a combination.

First, Spencer fails to teach or suggest that the secured network supports the distribution of an invention disclose, as in the claimed invention. Instead, Spencer is directed to the distribution of RFPs.

Secondly, Forrest et al. fails to teach or suggest using hyperlinks within an e-mail for distributing the invention disclosure to the appropriate evaluators, as in the claimed invention. The Applicants respectfully submit that it would not have been obvious to use hyperlinks when combined with distribution of an invention disclosure. Moreover, Forrest et al. teaches away from hyperlinks because the disclosed system is not web based, and consequently, each evaluator receives the actual invention disclosure (column 6, line 66 to column 7, line 6) instead of a hyperlink to the invention disclosure.

In other words, there must be some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of Spencer and Forrest et al. as suggested by the Examiner in an attempt to arrive at the claimed invention. The prior art references, individually, or in combination, do not teach or suggest such a combination.

Accordingly, it is submitted that independent Claim 1 is patentable over Spencer in view of Forrest et al. Independent Claims 12, 22, 31, 42, 52 and 61 are similar to independent Claim 1. Therefore, it is submitted that these claims are also patentable over Spencer in view of Forrest et

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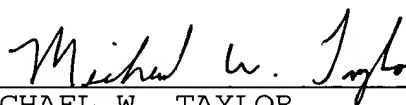
al. In view of the patentability of the independent Claims 1, 12, 22, 31, 42, 52 and 61, it is submitted that their dependent claims, which recite yet further distinguishing features of the invention, are also patentable. These dependent claims require no further discussion herein.

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CONCLUSION

In view of the arguments provided herein, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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